

REMARKS

Restriction Requirement

Pursuant to 35 U.S.C. §121, the Office Action mailed January 31, 2005 requires restriction of the claim set comprising claims 1 through 20 to a group of claims comprising one of two inventions identified in the Office Action. The Office Action groups the claims into the following two groups: claims 1-15 and 22-25 (Group I), and claims 16-21 (Group II).

The Restriction Requirement is respectfully traversed for the reasons set forth in the following paragraphs. However, affirmation of the provisional election of **Group I**, consisting of **claims 1-15 and 22-25**, is hereby provided.

The Restriction Requirement is improper because the Office Action has not shown that a search and examination of the entire application causes a serious burden as required by Section 803 of the MPEP.

**CRITERIA FOR RESTRICTION BETWEEN
PATENTABLY DISTINCT INVENTIONS**

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and
- (B) **There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).**

MPEP § 803 at page 800-4 (Emphasis added). Contrary to the requirements for a proper Restriction Requirement, maintaining this Restriction Requirement places a “serious burden” on the operation of the Patent Office, the public and the applicants. Filing additional applications directed to the non-elected inventions unnecessarily burdens the Patent Office because it must assume the additional and unnecessary labor involved in examining separate applications. The public is burdened because it has to locate and review at least two patents (due to the further restriction of an individual species) instead of one in order to fully ascertain the scope of the patent protection provided the subject matter in the specification. Finally, the applicants are burdened because they must bear the expense of filing and prosecuting multiple applications. This last consideration is particularly severe in this application as the assignee does not have an unlimited budget for patents.

In contrast to the burdens to the ongoing operation of the Patent Office, the public and the applicants, the burden of examining all of the claims instead of just those of one group is negligible. In this regard, the searches the Examiner must conduct for the two groups of claims are likely to overlap. In fact, a complete search of the claims for Group I is likely to include all of or at least most of the field of search for the claims of Group II. Additionally, the effort required to apply any art found is likely to be less than the burden of the public in finding and reviewing at least two patents due to the unnecessary restriction requirement.

The Restriction Requirement should be withdrawn and all of the claims examined for compliance with regard to the relevant requirements of the patent statutes, rules and regulations. The Examiner is respectfully requested to examine all of the claims. In any event, applicants provisionally elect the claims of Group I in the Office Action as identified above.

The Office Action and cited references have been carefully reviewed. Claims 1, 2, and 7 – 12 are rejected. The examiner has acknowledged that claims 3 - 6, and 13-15 are directed to allowable subject matter. Claims 22-25 are allowed. Claims 2, 3, 7-11, 13, and 15 have been amended.

Claim Rejections under 35 USC §102

It is axiomatic in patent law that to reject a claim under 35 U.S.C. § 102, each and every limitation must be found, expressly or inherently, in a single reference and arranged as required by the claims such that the reference discloses the identical invention. *See* M.P.E.P. § 2131. Anticipation is not established if in reading a claim on something disclosed in a reference it is necessary to pick, choose, and combine various portions of the disclosure not directly related to each other by the teachings of the reference. *See Ex parte Beuther*, 71 USPQ2d 1313 (BdPatApp&Int 2003), citing *In re Arkley*, 172 USPQ 524, 526 (CCPA 1972). A reference applied as anticipatory of the claimed invention under 35 U.S.C. § 102 must be enabling so as to place one of ordinary skill in the art in possession of the claimed invention. *See Akzo N.V. v. United States Int'l Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986) cert. denied, 482 U.S. 909, (1987); *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

Claims 1, 2, 7, 8, and 10 have been rejected under 35 U.S.C. 102(b) as being anticipated by Marchal (U.S. Patent 5,386,965). Claim 1 has been canceled. Claims 2, 7, 8, and 10 have been amended to depend from objected to claim 3, which has been amended to be independent form, and are believed to be allowable for the same reasons as claim 3. In view of the cancellation of claim 1 and the change in dependence of claims 2, 7, 8, and 10, the rejection of these claims is believed moot. It is therefore respectfully requested that the Examiner withdraw the rejection of claims 1, 2, 7, 8, and 10.

Claim Rejections under 35 USC §103

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one skilled in the art, to modify the reference or combine teachings. Any proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. There must be a reasonable expectation of success and the prior art references must teach or suggest all of the claim limitations. See M.P.E.P. 2143. Conclusory statements cannot be relied on when dealing with particular combinations of prior art and specific claims. The rationale for combining references must be put forth. *In re Lee*, 61 U.S.P.Q.2d 1430, 1433. The Examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

In its decision in *In re Lee*, the Federal Circuit reiterated and clarified the principle that a conclusory and ungrounded statement of motivation to combine is legally unacceptable. Specifically, the Federal Circuit noted that conclusory statements regarding motivation to combine are in violation of the PTO's federal mandate. (*See Lee*, at 1434 ("Omission of a relevant factor [i.e. motivation to combine] required by precedent is both legal error and arbitrary agency action. ... Conclusory statements ... do not fulfill the agency's obligation...").) Thus, a simple statement of beneficial results that would follow from a combination is *not* a motivation to actually make the combination. The fact that a combination *can* be made to get the beneficial results that the Applicants disclosed does not amount to a motivation found *in the art* to make that very combination. *See McGinley v. Franklin Sports, Inc.* 262 F.3d 1339, 1351, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of

patent claims, the law requires some 'teaching, suggestion or reason' to combine cited references.")

Claims 1, 2, and 7 - 12 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Banks (U.S. Patent # 4,341,370 in view of Marchal '965). This ground of rejection is respectfully traversed.

As previously indicated, claim 1 has been canceled. Claims 2, 7, 8, and 10-11 have been amended to depend from objected to claim 3, which has been amended to be independent form, and are believed to be allowable for the same reasons as claim 3. In view of the cancellation of claim 1 and the change in dependence of claims 2, 7 - 8, and 10 - 11, the rejection of these claims is believed moot. Claim 12 depends from claim 11. It is therefore respectfully requested that the Examiner withdraw the rejection of claims 2, 7 - 8, and 10 - 12.

With respect to claim 9, claim 9 requires that the valve member be a fuel metering valve that meters fuel flowing along the flow passageway to a turbine engine. No teaching or suggestion could be found in Banks ' 370 or Marchal '965 of the valve member being a fuel metering valve that meters fuel flowing along the flow passageway to a turbine engine.

Furthermore, the Office Action states that "It would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the valve of Banks with a piston and second side vent as, for example, taught by Marchal in order to improve the pressure balancing and valve actuation procedure.." It is respectfully submitted that this statement is merely a conclusory statement prohibited by *In re Lee* as conclusory statements regarding motivation to combine are in violation of the PTO's federal mandate.

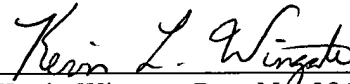
In view of the foregoing, it is respectfully submitted that a *prima facie* case of obviousness has not been put forth. It is therefore respectfully requested that the rejection of claim 9 be withdrawn.

In re Appln. Of: Jeff A. Gessaman
Application No.: 10/695,403

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

A handwritten signature in cursive script, reading "Kevin L. Wingate", positioned above a horizontal line.

Kevin Wingate, Reg. No. 38662
Reinhart Boerner Van Deuren, P.C.
483 North Mulford, Suite 7
Rockford, Illinois 61107-5191
(815) 484-1400 (telephone)
(815) 484-1032 (facsimile)

Date: June 24, 2005